

REMARKS

Claims 1-5 and 7-11 are pending within the present application. Claims 1-2 and 4-5 have been amended to indicate that the film is an amorphous coprecipitate of the two oxide hydroxides required, as well as to change the term "coating" to coprecipitate for uniformity purposes and to adjust the claim dependencies for clarification. Proper support is found throughout the originally filed specification for the amorphous limitation. Claims 7-11 are "new" only in the sense that they include the previously claimed and examined limitations of a copolymer of the same oxide hydroxides as noted above, but have now been separated from the coprecipitate requirements for clarification reasons. The "amorphous" limitation, as above, finds support throughout the originally filed specification for these same claims. Finally, the term "majority" as applied to the goethite component of both the claimed coprecipitate and copolymer is found within the originally filed specification in terms of at least 50% be such a component and such is formed through controlling the pH and other production conditions during film formation on the target textile. No new matter has been added and, in view of the withdrawal of Claim 6, as well, it is respectfully submitted that all of the previous rejections under 35 U.S.C. § 112 have been rendered moot thereby. Entry and due consideration of such amendments and reconsideration and withdrawal of such improper indefiniteness, etc., rejections are earnestly solicited.

The Office's retention of the rejections over Claims 1-6 under 35 U.S.C. § 112, first and second paragraph, have been overcome, in Applicants' position, as noted above. In particular, the inclusion of the term "amorphous" as describing the coprecipitate and copolymer requirements of the pending claims has been made in response to the Office's belief that the

claimed invention is a three-dimensional crystal lattice structure and thus the term copolymer is improper. Although Applicants do not fully understand the issue in such terms as presented by the Office, in an earnest attempt to remedy this problem, they have included the amorphous limitation to clarify the situation and assuage, once and for all, the Office's problems to this end. As the Applicants can be their own lexicographers, and the term copolymer is clearly defined throughout the specification, and the invention is required to be amorphous in structure, there should be no issue outstanding concerning this point. Reconsideration and withdrawal of these bases of rejection are thus earnestly solicited.

The Office has also rejected Claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Oishi et al. in view of Watanabe et al. Oishi et al. Are directed to the formation of plated films of ferrite on certain substrates; there is no disclosure or suggestion of a non-crystalline film anywhere within the four corners of this patent. The examples, not to mention the drawings, in particular Figs. 9a-c, all allude to the presence of particulate, three-dimensional crystal lattices of ferrites on the target substrates. Thus, on its face, this reference fails to provide any teaching commensurate with the claims at issue (see, in particular, col. 1, lines 16-26 for the basic discussion of electroless plating of ferrite films on substrates; the remainder of the reference discusses improving upon this base procedure in order to prevent production of by-products and unwanted extra particulates other than the films having "high crystallinity").

Compounding this initial problem, Oishi et al. fail to provide any actual suggestion or motivation to the ordinarily skilled artisan to form any oxide hydroxides of any metal species, let alone specifically aluminum oxide hydroxide as now required as a separate component of the

claimed coprecipitates and copolymers. At best, Oishi et al. permit the inclusion of certain metal ions to form metal ferrites (which are, again, particulate in nature (review col. 2, line 58-col. 3, line 10). There is no discussion of the ability, let alone possibility, of introducing a separate aluminum salt for the purpose of forming an amorphous iron oxide hydroxide-aluminum oxide hydroxide coprecipitate or copolymer. The Oishi et al. examples all show the introduction of metal salts for the production of crystalline metal ferrite films. In essence, Oishi et al. is not helpful for the ordinarily skilled artisan to produce anything other than a crystalline ferrite film, and possibly a metal ferrite film.

Watanabe et al. fail to remedy this lack of teaching as, as noted in previous submissions to the Office, *ad nauseum*, Watanabe et al. fails to teach any production of any precipitate or polymer of iron oxide hydroxides (not to mention coprecipitates or copolymers with aluminum oxide hydroxides). Nor do patentees remedy this problem as they are concerned with improving pigment technology for cosmetics, nothing else. Initially, then, nowhere within either reference or within the combination (if such a combination were somehow considered proper) of the two references is the "invention as a whole" as claimed taught or suggested.

In addition, as alluded to above, due to the disparity of art between these two references, the combination of Watanabe et al. with Oishi et al. is simply improper and thus is not a proper basis of rejection over the pending claims since the teachings of references can be combined only if there is some suggestion or incentive to do so, ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Where is the motivation that one of ordinary skill in the crystalline ferrite film art would have reviewed the cosmetic pigment art for

a proper additive within a crystalline ferrite film? Clearly, such a person would not have performed such a review. The Office seems to think that since both references mention metal oxides for deposition in some fashion on substrates that that is sufficient for finding analogousness between art references. However, the totality of the circumstances simply militate against such a result, primarily since the basic rationale for combining references from the standpoint of the ordinarily skilled artisan must be taken into consideration. There is no indication in either reference that reviewing transparent cosmetic pigments would lend technological advancements to the crystalline ferrite film art. The only real similarities between the cited references begin and end at the presence of metal oxides, nothing more. Just because such compounds are present within both references does not make the two patents analogous for combination purposes, however. For example, just because a foodstuff may include an emulsifier therein does not automatically make a detergent analogous thereto just because it too includes an emulsifier component. There are ample uses and purposes for metal oxides within myriad applications throughout many diverse arts. The line must be drawn at some point wherein the ordinarily skilled artisan would actually review a specific art reference for a valid motivated reason. Such is simply not the case here. What teaching or suggestion in the applied prior art would there have been for such an artisan to take the crystalline ferrite films of Oishi et al. and modify it by introducing a cosmetic pigment additive from Watanabe et al.? Applicants fail to see any such motivation.

Additionally, the aluminum salt of Watanabe et al. is not even a required component of patentees' formulations; the citation of such a salt is in a laundry list of potential additives and thus the presence of such a component is not critical for any distinct purpose. Again, how would one of ordinary skill in the pertinent art be inclined to introduce such an optional salt from a cosmetic pigment formulation within Oishi et al.'s crystalline ferrite films? Again, such a combination is improper in Applicant's view.

Furthermore, and most importantly, there simply is no motivation to introduce an optional aluminum salt from Watanabe et al.'s solid substrate pigment production methods into Oishi et al.'s crystalline ferrite films. Watanabe et al.'s salts must be mixed in with other oxides or hydroxides and with the substrate for pigment deposition (glass, etc.). Thus, even if any motivation existed to introduce the aluminum salts of Watanabe et al. within Oishi et al., such a solid substrate pigment as in Watanabe et al. could only be introduced within Oishi et al.'s teachings by applying that pigment to the already-formed crystalline ferrite film surface. There would be no way that the ferrite film would then copolymerize with the aluminum salt (not to mention the required aluminum oxide hydroxide of the present claims) to form the currently claimed coprecipitate or copolymer-coated textile therewith. Therefore, in this respect, again, there would be no way this combination could teach Applicants' "invention as a whole" as is required of a proper *prima facie* obviousness rejection. Gillette Company v. S.C. Johnson & Son, Inc., 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990); Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 221, 226 (Fed. Cir. 1984).


Clearly, then, in relation to all of the strata of arguments presented above, the only manner in which the Office actually proffers this basis of rejection is the improper hindsight reconstruction of Applicants' own teachings. It is understood by Applicant that some reconstruction is needed to provide obviousness rejections by the Office; however, the lengths to which the Office has gone to provide this basis of rejection is too far afield to be considered anything but improper in this instance, regardless of the level of knowledge imputed to the ordinarily skilled artisan. There is no way a combination of the two references, proper or improper as the case may be, could provide a proper teaching that would lead to the same claimed textile composites as now claimed. By definition, the application of rejections to that extent are based upon improper hindsight reconstruction as posited by Applicants above. Reconsideration and withdrawal of such an untenable rejection are thus earnestly solicited.

CONCLUSION

In view of all of the previous amendments and arguments, it is respectfully submitted that the pending claims are in condition for allowance and it is requested that this application be passed on to issue.

Respectfully submitted,

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